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62

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,973	05/30/2001	Ronald Paul Rohrbach	H0001202	8302

7590 01/06/2004

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EXAMINER

CINTINS, IVARS C

ART UNIT PAPER NUMBER

1724

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/867,973	Applicant(s) ROHRBACH ET AL.	
	Examiner Ivars C. Cintins	Art Unit 1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1724

The Terminal Disclaimer filed September 25, 2003 has been entered, and is deemed to overcome the obviousness-type double patenting rejection applied in the previous Office Action.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by DeJovine (U.S. Patent No. 4,144,166). DeJovine discloses an oil filter comprising a hollow housing 6 having an inlet 8 and an outlet 10, a mechanically active filter member 4 disposed inside the housing, and a chemically active filter member 2 disposed inside this housing. The chemically active filter member 2 includes a plurality of particles, which particles can include a beneficial additive of the type recited (see col. 11, lines 49-51). The reference also teaches that alkaline agents such as calcium carbonate and calcium hydroxide may be incorporated into the chemically active filter member (see col. 11, lines 57-58). This reference further discloses utilizing a polymeric binder of the type recited (see col. 3, line 20); and this is all that is required by claims 1-3, 5 and 6. Applicant should note that the manner in which the particles are produced (claim 6) is not a structural limitation, and hence cannot be given weight in determining patentability of an apparatus claim.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeJovine in view of Bilski et al. (U.S. Patent No. 5,725,031). DeJovine discloses the claimed invention with the exception of the location of the chemically active filter element with respect to the mechanically active filter element. Bilski et al. discloses a similar oil filter containing both a mechanically active filter element and means for adding an anti-wear chemical to oil undergoing treatment, and further discloses (see Fig. 1) locating the chemical adding element radially and coaxially inside the mechanically active filter element. It would have been obvious to one of ordinary skill in the art at the time the invention was made to locate the chemically active filter element (i.e. 2) of the DeJovine device inside the mechanically active filter element (i.e. 4), as suggested by Bilski et al, in order to produce a more compact filtration and treatment device.

Claims 7-10 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeJovine in view of Brownawell (U.S. Patent No. 5,225,081). DeJovine discloses the claimed invention with the exception of the construction of the filter housing and/or supplemental cartridge, and the size of the particles in the chemically active filter element. Brownawell discloses an oil filter having both a mechanically active filter member and a chemically active filter member, and further shows a filter housing and supplemental cartridge having the recited construction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the filter housing of DeJovine in the manner suggested by Brownawell, in order to provide a device with easily replaceable components. Also, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ particles having the recited size in the system of DeJovine, since this primary reference

Art Unit: 1724

clearly teaches (see col. 2, lines 57-60) that the size of the particles employed is not critical and may vary over a wide range.

The tardy reinstatement of the rejection based on DeJovine, as applied in the Office action dated September 4, 2002, is regretted; however, Applicant's remarks contained in the response filed January 13, 2003 are no longer deemed to be persuasive of patentability, for the following reasons. Applicant has argued that DeJovine uses particles and an oil-soluble polymer that dissolves over time to release these particles into the engine oil, whereas Applicant's claimed invention immobilizes the antioxidants in particles such that they are retained in the oil filter. It is pointed out, however, that DeJovine discloses an embodiment wherein the polymer used to support the additive particles is relatively oil-insoluble (see col. 3, lines 10-12). Furthermore, since the type of polymeric binder utilized by DeJovine (i.e. a thermoplastic such as ethylene-propylene copolymer; see col. 3, lines 5 and 20) is the same as that utilized by Applicant (see page 9, lines 14-15 of the specification), this reference polymeric binder must inherently have the same solubility characteristics in oil, as does Applicant's polymeric binder. Accordingly, in this embodiment the antioxidants will also appear to be retained within the filter for a significant period of time, for the same reason that Applicant's material produces this result. Moreover, even if the polymer employed by DeJovine is oil-soluble, the oil additive particles of this reference filter will only be released into the oil during its use; and prior to such use, these additive particles will also be retained in the filter, as recited in the claims of this application.

A copy of the Brownawell reference is not being furnished with this Office action because Applicant cited this document in the IDS filed December 11, 2001.

Application/Control Number: 09/867,973


Page 5

Art Unit: 1724

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (571) 272-1155. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Blaine Copenheaver, can be reached at (571) 272-1156.

The centralized facsimile number for the USPTO is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-0987.


Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
December 23, 2003